

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | | |
|--------------|-------------------|---------------|-------------------|
| Application: | 10/658,338 | Unit No.: | 3724 |
| Title: | Lock Removal Tool | Examiner: | Blake, Carolyn T. |
| Inventor: | Bosse | | |
| Filing Date: | 09/11/2003 | Our File No.: | 05-126 |

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT

Dear Ms. Blake:

The Applicant, by counsel, submits the following response to the Office Action from the Patent Examining Attorney dated January 30, 2006 (Office Action No. 1), regarding the application identified above ("the Application"). Please consider the following remarks supporting the granting of the patent:

- I. THE EXAMINER HAS NOT SHOWN ANY SUGGESTION OR MOTIVATION TO MODIFY OR COMBINE THE REFERENCED TEACHINGS AS REQUIRED BY MPEP 2143.

Applicant urges that the references cited by the Examiner and arguments presented by the Examiner do not establish a prima facie case of obviousness under 35 USC §103(a). "The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness. ...The initial evaluation of prima facie obviousness thus relieves both the examiner and applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention. (Emphasis added.)" MPEP 2142. Thus, Examiner must follow the criteria necessary to establish a prima facie case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine referenced teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claimed limitations. MPEP 2143.

Applicant urges that the above criteria have not been met in regard to the instant invention.

Examiner has put forward no evidence beyond conclusory statements that it would be “obvious to one of ordinary skill in the art to” modify the references. Furthermore, the ability to modify the reference does not necessarily establish a prima facie case of obviousness.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680; 16 USPQ 2d 1430 (Fed. Cir. 1990); MPEP 2143.01.

The Examiner is required to provide some suggestion or motivation to combine the Allen, Gue, Gallo and Harpell references. At no time during the prosecution of this application has Examiner cited any reference which discloses the suggestion or motivation that Allen, Gue, Gallo and Harpell could be combined, but has rather stated only that it “would have been obvious to one skilled in the art” without any supporting citations. Therefore, it can only be assumed that Examiner has relied on the teachings of the present application as the motivation to modify. Such use of Applicant’s own disclosure is expressly prohibited and inappropriate in a 35 U.S.C. §103 rejection. “The teaching or suggestion to make the claim combination and the reasonable expectation of success must be both found in the prior art, not in Applicant’s disclosure.” In re Vaeck, 947 F2d 488 (Fed. Cir. 1991). The prior art items themselves must suggest the desirability and thus the obviousness of making the combination without the slightest recourse to the teachings of the patent application. Without such independent suggestion, the prior art is to be considered merely to be inviting unguided and speculative experimentation, which is not the

standard with which obviousness is determined. Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd., 927 F.2d. 1200 (Fed. Cir. 1991).

The Examiner has thus used impermissible hindsight reconstruction, taking the direct teachings of the present application and filling in the gaps, which are neither evident nor even remotely suggested in the cited references. Impermissible hindsight must be avoided, and the legal conclusion of obviousness must be reached on the basis of the facts gleaned from the prior art. (See MPEP §2142).

II. REFERENCES ARE NOT PROPERLY COMBINABLE OR MODIFIABLE IF THEIR INTENDED FUNCTION IS DESTROYED.

It is clear from the case law that if a prior art reference is cited that requires some modification in order to meet the claimed invention or requires some modification in order to be properly combined with another reference and such a modification destroys the purpose or function of the invention disclosed in the reference, one of ordinary skill in the art would not have found a reason to make the claimed modification. Thus, the CCPA and the Federal Circuit has consistently held that when a 35 U.S.C. §103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and the prima facie case of obviousness cannot be properly made.

This issue was addressed in In re Gorden, 733 F.2d. 900, 221 USPQ 1125 (Fed. Cir. 1984), involving a blood filter assembly used during surgery and other medical procedures. The prior art at issue was a patent to French that disclosed a liquid strainer for removing dirt and water from gasoline and other light oils. In contrast to the claimed blood filter assembly, the inlet and outlet in the French device were located at the top, whereby gravity assisted in the separation of heavier oils or water. The USPTO asserted that it would have been obvious to turn the French device upside down to have the

inlet and outlet at the bottom and that no patentable distinction was created by viewing the French device from one direction and claimed assembly from the other. In rejecting the position of the USPTO, the court held:

The question is not whether a patentable distinction is created by viewing a prior art apparatus from one direction and a claimed apparatus from another, but, rather, whether it would have been obvious from a fair reading of the prior art reference as a whole to turn the prior art apparatus upside down. French teaches a liquid strainer which relies, at least in part, upon the assistance of gravity to separate undesired dirt and water from gasoline and other light oils. Therefore, it is not seen that French would have provided any motivation to one of ordinary skill in the art to employ the French apparatus in an upside down orientation. The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.

In re Gorden, 733 F.2d at 902, 221 USPQ at 1127.

- A. The intended function of the Gue tool, a rock-breaking tool, would be destroyed if combined with the Allen, Gallo or Harpell reference.

Examiner incorrectly states that the Gue tool is a “lock removal tool.” This is inaccurate for the title of the application is a “rock-breaking tool.” The Gue reference states in the Background of the Invention: “this invention relates to rock-breaking tools of the type used by professional geologists and amateur ‘rock hounds.’ And more particularly, to an integrated tool which performs a function of a rock chisel and sledge.” An important object of the invention in Gue is to provide a “rock-breaking tool of simplified and rugged construction for economical manufacture and for heavy duty, and which enables the breaking of a rock with speed and precision” (emphasis added).

To replace the chiseled edge of the rock-breaking tool with the prying section 24 of the Gallo tool or the forged end of the Allen tool would destroy the intended function of the Gue tool, which is to provide sufficient force behind a sharp chiseled tip break a rock apart. Likewise, if the Harpell cutting

tool replaced the chisel and formed edge of the elongated steel bar of Gue, then the tool would be a completely different product, incapable of achieving the primary objective listed in the patent application, which is breaking rock. The cutting tool of Harpell and the slotted pry bar of Gallo and Allen are not capable of receiving a rock. The blunt edges of each of these tools simply would not provide the chiseled edge required to split a rock. Also, the strength of the Gue tool would be severely diminished by adding a cutting tool such as the one shown in the Harpell reference. The strength of the tool would thus be limited to the strength of the connection of the cutting tool and bar versus the strength of a single forged bar. This limitation in the strength and durability of the tool alone would prevent it from achieving its intended function.

By combining these references as suggested by the Examiner, the Gue tool would lose the most instrumental aspect of its intended purpose, the pointed chisel, which is used to break rocks open.

- B. Modification of the tool in the Gallo reference would destroy its intended function, which is a nail remover.

Like the Gue reference, the Examiner also incorrectly identifies the tool shown in the Gallo reference as a “lock cutting tool.” Rather, the title for the Gallo reference identifies the tool as a “pry bar with built in hammer and nail remover.” The primary function of the Gallo invention is “to provide a pry bar with a built-in hammer and nail remover for use in roofing.” The Examiner has argued that it would have been obvious to one skilled in the art to combine the Gue/Gallo combination with the Harpell reference. Applicant argues that to replace the forged pry bar end of the Gallo reference with the cutting tool of Harpell would destroy its intended function which would be to “pry” nails from the roof. Throughout the Gallo patent, there are several references to “prying the nails up” or “prying up

the nail” or “fully removing the nail from the roof.” The Gallo references clearly place an importance on being able to pry “up” old nails and remove them from a roof.

If the cutting tool of Harpell were to replace the forged pry section 24 of the Gallo tool, it would not be capable of prying up nails due to the true trailing rear edge of the cutting tool which extends beyond the connecting bar or handle. The trailing rear edge would prevent the prying or lifting up action, which is required to remove a nail from any surface. This is the distinction between a pry bar and a cutting tool. The pry bar cannot have a true trailing edge as in order to perform the prying function, it must be able to rotate in a rearward fashion to pull the nail “up.” The cutting tool of the Harpell reference does not pry but rather performs its function by cutting. By substitution the cutting tool of the Harpell reference on the Gallo tool, the nail head would simply be cut off, leaving the arm of the nail in the roof, which is an undesirable situation.

Finally, similar to the Gue reference, by adding a cutting tool which is adjoined to the bar or handle, the strength of the Gallo tool would greatly diminished, thus preventing it from performing its intended function.

- C. The rod member 13 of the Harpell tool makes the combination with the Gue/Gallo reference completely unnecessary and combining the references destroys the Harpell tool’s intended function.

As argued above, the Applicant believes that it is not obvious to combine the Gue and Gallo references. However, in response to the Examiner’s argument that it would be obvious to combine the Gue/Gallo combination with the Harpell reference, the Applicant states that the Harpell reference does also not suggest or teach the addition of an impact collar and slide hammer accompaniment, which is present on the Gue and Gallo tools, and in fact directly teaches away from it.

The Harpell tool has a flat blade or cutting tool with a handle extending upwardly and rearwardly from the blade. The Harpell tool has an “impact receiving means” which comprises a “rod member 13, substantially thicker than the blade 3, fastened, as by welding, to the back edge 15 of the blade.” (See Colum 3, line 23 in Harpell reference.) The impact means for this tool is achieved by hammering directly on the rod portion on the back of the blade to force the blade forward. There is no suggestion or teaching in the Harpell reference to add an impact means directly on to the handle of the tool, and in fact, the use of the rod member makes the use of an impact bar and a slide hammer accompaniment a completely unnecessary addition. Moreover, given the angle of the attachment of the cutting tool to the handle of the tool, any impact provided by an impact collar and a slide hammer on the handle of the tool would not provide the forward force which would enable the blade to move forward and perform its required function. Instead, the angle at which the handle and the cutting tool are connected would provide a force merely pushing the tool downward onto the surface, not moving the cutting tool forward. Thus, for these reasons, there is no motivation or suggestion in the prior art for combining the Harpell blade with the Gue/Gallo combination and, in fact, the Harpell reference actually teaches away from the combination.

Examiner has also stated in her Office Action that FIG. 9 in Applicant’s application discloses a pry bar. The Applicant takes strong issue with this statement, as it has been previously argued to the Examiner that a pry bar is not in fact disclosed in FIG. 9 of Applicant’s application. A pry bar, by definition, is a heavy iron lever with one end forged into a wedge. FIG. 9 does not disclose the end of the pry bar forged into a wedge. Instead, it discloses an elongated bar with a cutting tool joined to the end of the bar, as opposed to being “forged” from a lever. Examiner has failed to appreciate this very important distinction. Just as Harpell is not a pry bar, neither is the Applicant’s invention. Even the

Examiner has noted the distinction by stating that the Harpell cutting tool may be “advantageous for use on a different work product,” and may be “easier to manufacture because it would not require an involved bending or casting operation.” Even though they may both be capable of performing a cutting function, NEITHER tools are capable of performing a prying function because of the trailing edge of the cutting tool. In order to pry something, it must be leveraged up and away, and this cannot be done with the Applicant’s invention. A pry bar by definition is a prying device, not necessarily a cutting device.

Also, in order to have the strength to pry apart items which are attached, a tool by its nature must be very strongly built without weak points subject to disengagement. The strength of a pry bar comes from the fact that there are no connected pieces but rather a solid bar with a forged or cast end. The cutting tool as shown by Applicant’s invention is not required to be as strong and relies more on the cutting edge which is an attached tool.

Therefore, Applicant urges that the criteria for establishing a prima facie case of obviousness have not been met by the rejection of claims 1-14. The claimed invention, as claimed in claim 1, a cutting tool with both a leading and trailing edge, which has a bar connected generally between the leading and trailing edge and said bar being angled away from the top surface of the cutting tool and extending rearward from the lock cutting tool is not disclosed, taught or suggested in the combination of Allen, Gue, Gallo and Harpell. Thus, Applicant respectfully requests that Examiner withdraw the 35 U.S.C. §103 rejections of Claims 1-14.

III. THE TOOL IN ALLEN DOES NOT SUPPORT EXAMINER'S 35 U.S.C. §102 REJECTIONS.

Applicant has argued several times the distinctions between the Allen reference and the Applicant's invention. The tool in the Allen reference is entitled a "slide hammer and nail puller." Throughout this response, the Applicant has attempted to point out again the distinction between a pry bar and a cutting tool. The Allen reference is a forged or cast lever which is absolutely necessary to perform the prying function which is obviously the intended function of the Allen tool. The Applicant's invention does not have the rounded feature, but instead has a cutting tool with a true trailing edge, which actually prevents it from performing a "prying" function. Instead, it relies on a cutting tool, which cuts objects apart as opposed to prying them apart. Likewise, the Allen reference is no "lock removal tool" as is argued by the Examiner but rather a nail puller. Like the Gallo reference, it is an important distinction, in that it is desirable that the entire nail be removed, not merely the head of the nail.

Additionally, without the true trailing edge found in Applicant's tool, the Allen reference does not disclose the recess necessary to lodge a security bar between that trailing edge and the impact collar, in order to provide an impact upon the security bar. None of the references cited disclose this feature which is present in Applicant's tool.

For the foregoing reasons, Applicant argues that Examiner's 35 U.S.C. §102 rejection is improper and therefore requests it be withdrawn.

CONCLUSION

Applicant states that claims 1-14 should all be allowed and thus, Applicant respectfully requests Examiner to reconsider the Application and to pass the present Application to allowance. However, if Examiner believes that unresolved issues remain in this case, Applicant respectfully requests Examiner contact Applicant's attorney of record listed below.

Respectfully submitted,

Laura M. Hagan
KERRICK, STIVERS & COYLE, P.L.C.
1025 State Street
P. O. Box 9547
Bowling Green, KY 42102
(270) 782-8160
Reg. No.: 38,902